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10/538,025	06/08/2005	Hiroyuki Sakai	8861-530US (544587)	8796

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EXAMINER

SANTIAGO, LUIS F

ART UNIT	PAPER NUMBER
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3624

NOTIFICATION DATE	DELIVERY MODE
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09/09/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/538,025	Applicant(s) SAKAI, HIROYUKI	
	Examiner LUIS SANTIAGO	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 13 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/08/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This is the office action in response to applicant submission filed on May 23, 2005, wherein claims 1 – 13 are pending and examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy (JP 02/12872) was filed on 12/09/2002.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 12 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 1 and 13 are drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter. To be statutory as part of an apparatus claim, a computer program must be coupled with or combined with some statutory physical structure. Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Applicant is reminded that apparatus claims give patent protection covering 'all uses' for the

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claimed apparatus” *Augustine Medical, Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 50 USPQ2d 1900, 1908 (Fed. Cir. 1999) (citations omitted).

Regarding Claim 12, Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 12 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

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Replacing Claim 13 with “a computer-executable program product comprising computer executable instructions tangibly embodied on a computer readable medium that when executed by said computer perform the method steps comprising...” is a suggestion for how to bring this claim into compliance with 35 U.S.C. 101 because “a computer-executable program tangibly embodied on a computer readable medium” is statutory subject matter. (See *In re Beauregard*, 35 USPQ2d 1383 (Fed. Cir. 1995).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 12 and 13** are rejected under U.S.C. 102(b) as being anticipated by Minemura et al. (JP 2000-101647) (Hereinafter referred to as Minemura)

With respect to **Claims 1, 12 and 13**:

Minemura teaches an apparatus for analyzing scenario information, comprising:

a scenario information storage section in which holds scenario information (See Abstract Minemura, scenario storage means 11);

a reference information storage section which holds reference information about the data included in said scenario information (See Abstract Minemura, storing reference data composing of a title and a scenario describing the time to reproduce the data);

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a calculating section which extracts said data from said scenario information and calculates output information based on said data extracted and said reference information (See Abstract Minemura, Calculating means 12 for preparing a schedule for transmitting data by calculating means 12 for preparing a schedule); and

an output section which produces said output information (See Abstract Minemura, at the terminal display timing of these data).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 3, 4, 6, 7 and 11** are rejected under 35 U.S.C. 103 (a) as being obvious over Minemura et al. (JP 2000-101647) as applied to claims 1, 12 and 13 above and further in view of Black et al (US 2002/0099577) (Hereinafter referred to as Black).

With respect to **Claims 3**:

Minemura teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, wherein said reference information includes at least one of schedules of casts/staff, unit prices of the casts/staff, use schedules of shooting places, unit prices of usage charges of the places, information about access to the places, use schedules of equipment/properties, unit prices of usage charges of the equipment/properties,

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information about suppliers of the equipment/properties or extras, the number of the extras available, unit prices of the extras, budget information, and deadline information.

However, Black teaches:

Unit prices of usage charges of the equipment. (Black, paragraphs 0025 and 0156 equipment and services, and labor or crew budget and use data).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated the apparatus for analyzing scenario information of claim 1, wherein said data includes at least one of shooting time data, shooting place data, data for casts/staff, data for equipment/properties, data for extras, and data for suppliers, which are derived from each scene as taught by Black, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

With respect to **Claims 4:**

Minemura teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, wherein said output information includes at least one of shooting schedules, shooting costs, a list of equipment/properties, and a list of suppliers.

However, Black teaches: (Black, paragraph 0165, shoot schedules).

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated shooting schedules as taught by Black, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

With respect to **Claims 6**:

Minemura teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, further comprising a setting section which sets parts of said output information to be fixed values, and wherein said calculating section extracts said data from said scenario information, and, based on said data extracted and said reference information, calculates output information other than said output information set to the fixed values.

However Black teaches: calculating section extracts said data from said scenario information. (Black, paragraphs 0055 - 0056 and 0058, a single point of access by which studios and their budgeters may review budgets, variances, vendor and inventory information).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated calculating section extracts said data from said scenario information as taught by Black, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

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With respect to **Claims 7**:

Minemura teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, wherein said scenario information storage section holds scenario information of a plurality of scenarios to which priority information is added, and said calculating section calculates said output information about the scenarios in order of priority, based on said priority information.

However, Black teaches: priority information is added. (Black, paragraphs 0081, aggregation of sub-lines, lines and other higher levels of the budget hierarchy).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated priority information is added as taught by Black, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

With respect to **Claim 11**:

Minemura teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, wherein said calculating section detects identifier information for each data included in said scenario information and extracts the information specified based on said identifier information as data relating to the identifier information.

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However, Black teaches: calculating section detects identifier information for each data included in said scenario information (Black, paragraph 0119, the budgeter is prompted to enter key crew, production and studio information) and the information specified based on said identifier information as data relating to the identifier information. (Black, paragraphs 0081-0082, budget identifiers, including budget estimates, memos, and messages).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated calculating section detects identifier information for each data included in said scenario information and the information specified based on said identifier information as data relating to the identifier information as taught by Black, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

9. **Claims 2, 5, 8, 9 and 10** are rejected under 35 U.S.C. 103 (a) as being obvious over Minemura et al. (JP 2000-101647) in views of Black et al (US 2002/0099577) as applied to claims 3, 4, 6, 7 and 11 above and further in view of Clark et al (US 6,466,655) (Hereinafter referred to as Clark).

With respect to **Claims 2**:

Minemura teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, wherein said data includes at least one of shooting time data, shooting place data, data for casts/staff, data for equipment/properties, data for extras, and data for suppliers, which are derived from each scene.

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However, Clark teaches: information data base (Clark Col. 5 line 40, to facilitate information data base organization).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated the apparatus for analyzing scenario information of claim 1, wherein said data includes at least one of shooting time data, shooting place data, data for casts/staff, data for equipment/properties, data for extras, and data for suppliers, which are derived from each scene as taught by Clark, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

Minemura does not specifically disclose of shooting time data, shooting place data.

However, Black teaches: shooting time data: (Black, paragraph 0161 “the crew sub-line input screen and by the Department scheduler).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated shooting time data as taught by Black, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

With respect to **Claims 5**:

The combination of Minemura and Black teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, wherein said

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reference information storage section holds said reference information to which added priority information, and when being unable to create output information which satisfies all of the requirements of said reference information, said calculating information calculates said output information based on said data extracted and said reference information from which said reference information having a low priority has been excluded on the basis of said priority information.

However, Clark teaches:

Information storage section holds said reference information to which added priority information. (Clark Col. 6, line 40, information or data relevant).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura and Black to have incorporated information storage section holds said reference information to which added priority information as taught by Clark, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

With respect to **Claim 8**:

The combination of Minemura and Black teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, further comprising a retrieval section, wherein said retrieval section retrieves from said scenario information storage section a scenario or a scene in a scenario which includes the same

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information as retrieval information received, and produces the information of the scenario or the scene in the scenario retrieved.

However Clark teaches: retrieval section retrieves from said scenario information storage section a scenario. (Clark Col. 6, lines 40 – 45, any information or data relevant to production administration).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura and Black to have incorporated retrieval section retrieves from said scenario information storage section a scenario as taught by Clark, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

With respect to **Claim 9**:

Minemura teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 8, wherein said retrieval information is one or a combination of shooting time data, shooting place data, data for casts/staff, data for equipment/properties, data for extras, and data for suppliers.

However, Black teaches: (Black, paragraphs 0161, 0131 and 0002). Shooting time data “Schedule data pertaining to crew is facilitated via the crew sub-line”, cast/staff “cast, production offices”, equipment “vendor users/equipment”.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated shooting time data,

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cast/staff, equipment as taught by Black, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

With respect to **Claim 10**:

Minemura teaches the above limitations, but does not specifically disclose the apparatus for analyzing scenario information of claim 1, further comprising an input section which receives time code information of a video or audio signal of each shot scenes or an identifier of the scene, wherein said scenario information storage section holds said identifier associated with the scenes of said scenario information, based on said time code information and said identifier received, said calculating section creates an editing list created according to the order of the scenes in the scenario, and said output section produces said editing list.

However, Clark teaches: an identifier of the scene. (Clark Col. 6, lines 40 – 50, image, video can be upload to the production).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated an identifier of the scene as taught by Clark, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

Minemura teaches the above limitations, but does not specifically disclose the output section produces said editing list.

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However, Black teaches: an output section (Black, paragraphs 0152 – 0153, once the budget is created, a PC budgeter can add items to budget lines).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the apparatus of Minemura to have incorporated an output section as taught by Black, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the result of the combination were predictable.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUIS SANTIAGO whose telephone number is (571) 270-5391. The examiner can normally be reached on Monday to Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

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would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/LFS/

August 31, 2009.

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624